THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID J. SANDERS
FRANCOISE M. WINNIK and MARCEL P. BRETON

Appeal No. 95-3537
Application 08/078,533[1]

ON BRIEF

Before JOHN D. SMITH, GARRIS and WARREN, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. ' 134 from the decision of the examiner refusing to allow claims 1 through 20 as amended subsequent to the final rejection.[2]

We have carefully considered the record before us, and based thereon, find that we cannot sustain the rejection of appealed claims 1 through 20 under 35 U.S.C ' 103 over AMiyamoto et al. or Fredrickson either taken in view of appellants= admissions (see for example page 22 of the specification) and further in view of Ma@ (answer, pages 2 through 5).[3] It is well settled that the

[1] Application for patent filed June 16, 1993.
[2] Amendment of August 19, 1994 (Paper No. 6).
[3] The references relied on by the examiner are listed at page 2 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

examiner must satisfy his or her burden of establishing a *prima facie* case of obviousness by showing some objective teaching or suggestion in the applied prior art taken as a whole or that knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants= disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-1076, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). We conclude that the examiner has not carried her burden.

The examiner has premised the rejection on the theory that A[o]nce thermal ink jet printing was known in the art, and the stringent requirements for the ink composition were known in the art, it would have been obvious to one of ordinary skill in the art to determine what types of compositions would be appropriate for thermal ink jet printing processes and which would not be@ (answer, page 6). However, while the claimed printing processes may involve basically simple concepts *per se* when considered from hindsight, that fact alone is not sufficient to establish a *prima facie* case of obviousness. *In re Horn*, 203 USPQ 969, 971 (CCPA 1979) (A[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness.@). Indeed, it is well settled that whether the claimed invention as a whole complies with ' 103 is determined by whether the combination of references applied in the rejection would have reasonably suggested to one of ordinary skill in this art both the claimed processes and the reasonable expectation that these processes can be successfully performed. *Fine, supra*; *Dow Chem., supra*.

We observe that the examiner has responded to appellants= argument that Aneither [Miyamoto et al. nor Fredrickson] teach or suggest the use of the specific desensitizing compositions recited in claims 11, 12, 13, 14, 18 and 19@ (principal brief, page 7)@ by stating that A[t]he Examiner agrees that these references were not relied upon for specific teachings of the desensitizing compositions recited by the instant claims@ (answer, pages 6-7). From our review of these references, we must agree with appellants (principal brief, pages 7-8) that neither of these references teaches or suggests a desensitizing composition comprising at least water, an organic component and a desensitizing agent as required by the appealed claims. The examiner also

acknowledges that AMa does not disclose printing a desensitizer composition@ (answer, page 7) and has relied on the admissions in appellants= specification (page 22) only to show that the desensitizer materials used in the desensitizer compositions of the claims were known in the art.

Accordingly, since the desensitizing compositions were not taught by the applied combination of references, the burden is on the examiner to enter into the record evidence and/or scientific reasoning explaining why one of ordinary skill in this art would have modified the desensitizing compositions taught by Miyamoto et al. and Fredrickson in order to arrive at the aqueous desensitizing compositions specified in the appealed claims in order to make out a *prima facie* case of obviousness. In the absence of such evidence and/or scientific reasoning, it is manifest that the only direction to appellants= claimed invention as a whole on the record before us is supplied by appellants= own specification.

The examiner=s decision is reversed.

Reversed

JOHN D. SMITH Administrative Patent Judge	)
BRADLEY R. GARRIS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
CHARLES F. WARREN Administrative Patent Judge	)

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